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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,151	10/17/2000	Bradley Engstrand	MOT-P-00-001	2732
7590 09/08/2004				
Patent + TMS A Professional Corporation 1914 N Milwaukee Avenue Third Floor Chicago, IL 60647			EXAMINER LUU, THANH X	
			ART UNIT 2878	PAPER NUMBER
DATE MAILED: 09/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,151

Applicant(s)

ENGSTRAND, BRADLEY

Examiner

Thanh X Luu

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Petition filed July 26, 2004 has been granted.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
3. This Office Action is in response to amendments and remarks filed July 26, 2004. Claims 1-22 are currently pending.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-10 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears that Applicant has failed to disclose an embodiment in which a sensor detects intensity of light which is absorbed by the coating on the interior surface.

6. Claims 1-10 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is unclear to one of ordinary skill in the art to make a sensor that detects intensity of light which is absorbed by a coating on an interior surface. As defined, the coating absorbs light. It is unclear how a sensor detects light that has already been absorbed by the coating.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Algers et al. (U.S. Patent 6,058,776).

Regarding claims 11-14, Algers et al. disclose (see Figure 1) an apparatus for cleaning a machine component, comprising: a machine element having a body defining an interior wherein the body has a length defined between a first end (at 15) and a second end (at 9) wherein the first end a wall (at wall of seal) having an opening and further wherein the wall has a surface which is exterior to the machine element; a shaft element (6) which is moved within the machine element wherein the shaft element extends through the opening in the wall; a head element (16) within the interior of the machine element wherein the head element is attached to the shaft element; and a first brush (see column 2, lines 53-55) positioned on the surface of the wall wherein the first brush is exterior to the machine element and contacts the shaft element. Algers et al. also disclose (see Figure 1) a seal (4) disposed around the shaft and a coating (5) on

the shaft element. Algers et al. also disclose a brush ring, which would inherently include a second brush. Algers et al. do not specifically disclose the brush on the exterior wall. However, Algers et al. do teach the brush combined with the sealing ring (4). Furthermore, it is a matter of design choice and a matter of routine skill in the art to choose where to provide a brush relative to a machine element. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the brush exterior to the machine element in the apparatus of Algers et al. to scrap particles outside the machine element in order to prevent deposits from entering the machine element and eventually fouling and clogging the device.

9. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Algers et al. in view of Fox et al.

Regarding claims 15 and 16, Algers et al. disclose the claimed invention as set forth above. Algers et al. do not specifically disclose a light source and sensor as claimed. Fox et al. teaches attaching a light source and sensor to measure a displacement of a head element. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a light source and sensor as claimed in the apparatus of Algers et al. in view of Fox et al. to verify correct operation of the machine element by monitoring the position of the head element.

Response to Arguments

10. Applicant's arguments with respect to claims 1-0 and 17-22 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's remarks with respect to claims 11-16 are found to be not persuasive. Simply relocating a brush to an exterior surface is a matter of design choice and requires only routine skill in the art, as set forth above.

Thus, since this application is not in condition for allowance this rejection is proper.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is (571) 272-2441. The examiner can normally be reached on M-F (6:30-4:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
Art Unit 2878

08/2004